

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 13 and 20 have been objected to.

Claims 13 and 20 are amended herein solely to correct typographical errors pointed out by the Examiner.

Reconsideration of Claims 1-20 is respectfully requested.

Claim Objections

The Office Action mailed November 4, 2004, objects to Claims 13 and 20 for informalities. The Applicant has amended Claims 13 and 20 to correct the typographical errors indicated by the Examiner. The Applicant respectfully requests the withdrawal of the objection to Claims 13 and 20.

Claim Rejections under 35 U.S.C. 102

The Office Action mailed November 4, 2004, rejects Claims 1-14 under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 2,990,213 to Kolacinski ("*Kolacinski*"). The Applicant respectfully traverses this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir.

1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Applicant respectfully disagrees with the rejection of Claims 1-14 and directs the Examiner's attention to independent Claim 1, which contains the unique and non-obvious limitations emphasized below:

1. (Original) A tool for lifting a pad, comprising:
 a jaw having an upper jaw portion and a lower jaw portion, the lower jaw portion having a sloped upper surface for slidably receiving a portion of the pad;
 a first member pivotally coupled to the jaw; and
 a second member pivotally coupled to the first member, the second member having a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards. (*emphasis added*)

The Applicant respectfully submits that the *Kolacinski* reference does not disclose, suggest, or even hint at the above-emphasized limitations of Claim 1.

In rejecting Claim 1, the Office Action asserts that reference numerals 20 and 21 of the *Kolacinski* reference indicate a jaw, with reference numeral 21 indicating an upper jaw portion and reference numeral 20 indicating a lower jaw portion. The Applicant respectfully submits that the Office Action mischaracterizes the teaching of the *Kolacinski* reference.

The drawings of the *Kolacinski* reference show "a holder or pliers generally designated 2 comprising a pair of lever members 3 and 4." *See Kolacinski, col. 1, lines 51-53*. "The members 4 and 3 respectively provide jaws 20 and 21." *See Kolacinski, col. 1, lines 64-65*. Thus, the

Kolacinski reference discloses a holder or pliers with a pair of jaws 20 and 21. In contrast, Claim 1 recites a single jaw, having an upper portion and a lower portion

The Office Action further asserts that either reference numeral 12 or 13 indicates a first member pivotally coupled to the jaw. Reference numeral 12 refers to the handle portion of lever member 3, at the opposite end from jaw 21. Similarly, reference numeral 13 refers to the handle portion of lever member 4, at the opposite end from jaw 20. *See Kolacinski, Fig. 1, col. 1, line 60.* Thus the *Kolacinski* reference teaches a lever member with a jaw at one end and a handle portion at the other end, rather than a first member pivotally coupled to a jaw, as recited in Claim 1.

Therefore, independent Claim 1 contains unique and non-obvious limitations that are not disclosed, suggested, or even hinted at in the *Kolacinski* reference. This being the case, Claim 1 is patentable over the *Kolacinski* reference. Dependent Claims 2-7 depend from independent Claim 1 and contain all of the unique and non-obvious limitations recited in Claim 1. Thus, Claims 2-7 also are patentable over the *Kolacinski* reference. For these reasons, the Applicant respectfully requests that the rejection of Claims 1-7 under 35 U.S.C. § 102 be withdrawn and that Claims 1-7 be passed to allowance.

Additionally, independent Claim 8 contains limitations that are analogous to the unique and non-obvious limitations recited in Claim 1. This being the case, Claim 8 is patentable over the *Kolacinski* reference. Finally, dependent Claims 9-14, which depend from independent Claim 8, contain all of the unique and non-obvious limitations recited in Claim 8. Thus, Claims 9-14 are patentable over the *Kolacinski* reference. For these reasons, the Applicant respectfully requests that

the rejection of Claims 8-14 under 35 U.S.C. § 102 be withdrawn and that Claims 8-14 be passed to allowance.

Claim Rejections under 35 U.S.C. 103

The Office Action mailed November 4, 2004, rejects Claims 15-20 under 35 U.S.C. 103(a) as being unpatentable over *Kolacinski* in view of United States Patent No. 6,086, 126 to Krauss (“*Krauss*”). The Applicant respectfully traverses this rejection.

The Applicant respectfully directs the Examiner’s attention to independent Claim 15, which contains the unique and non-obvious limitations emphasized below:

15. (Original) A chemical mechanical polishing pad removal tool; comprising:

a jaw having an upper jaw portion and a lower jaw portion, the upper jaw portion having an arcuate lower surface for contacting portions of an upper surface of the chemical mechanical polishing pad, the lower jaw portion having a sloped upper surface spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the pad, the sloped upper surface terminating at a lower end in a rounded end;

a handle pivotally coupled to the jaw; and

a member pivotally coupled to the handle, the member having a textured surface projecting below the arcuate lower surface of the upper jaw portion and being opposite to the sloped surface of the lower jaw portion, the textured surface being operable for clamping the portion of the pad against the sloped surface when the handle is pivoted upwards.

The Applicant respectfully submits that, for the same reasons described with regard to Claim 1, the *Kolacinski* reference does not disclose, suggest, or even hint at the above-emphasized limitations of Claim 15. The *Krauss* reference does nothing to overcome this shortcoming. Therefore independent Claim 15 presents patentable subject matter over the *Kolacinski* reference, the *Krauss* reference, or

the combination of the *Kolacinski* and *Krauss* references. For these reasons, the Applicant respectfully requests that the rejection of Claims 15-20 under 35 U.S.C. § 103 be withdrawn and that Claims 15-20 be passed to allowance.

SUMMARY

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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William A. Munck
Registration No. 39,308

P.O. Drawer 802432
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *wmunck@davismunck.com*